

Serial No. 10/603,122 filed 6/24/2003
Amendment dated August 8, 2005
in Response to Office Action of February 7, 2005

Remarks

Receipt is acknowledged of the Office Action of February 7, 2005. Reconsideration of the application and a three month extension of the time provided for response are respectfully requested. The Commissioner is hereby authorized to debit all amounts deemed required from Deposit Account No. 50-1604.

In the Office Action, the pending claims were rejected under 35 U.S.C. §101 and 112 on the grounds that they embrace more than one statutory class of invention under *Ex parte Lyell*. See, *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. and Int. 1990). In *Lyell*, however, the claims in question purported to encompass both a tool itself and a method for its use - with the same claim being directed to both the product and the method. In contrast, the claims previously presented only recited a method. Namely, a method was claimed of providing a certain type of container for the purpose of entertaining a child. Accordingly, Applicant respectfully submits that the previously submitted claims fully presented statutory subject matter.

To expedite an allowance, Applicant has amended the claims as set forth above to recite apparatus claims only. However, Applicant reserves the right to present claims in the same scope as previously submitted in the future whether in the present application or in a continuation.

In view of the amendment, reconsideration and withdrawal of the §101 and §112 rejections is respectfully requested.

In the Office Action, independent claim 1 (and its dependent claims) were also rejected under 35 U.S.C. §103(a) based upon the combination of Banschick (U.S. Patent 5,683,762) with DiPersio (U.S. Patent No. 4,776,593). Reconsideration of the rejections is respectfully requested.

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Under 35 U.S.C. §103, "to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor, or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned". *See*, M.P.E.P. 2141.01(a) (Eighth Ed. Rev. 2, May 2004, p. 2100-122). DiPersio, however, relates to a VCR baseball game. It is not in the field of cosmetic containers, nor is it reasonably pertinent to the problem of designing cosmetics containers. Accordingly, DiPersio is non-analogous art and cannot be relied on for an obviousness rejection under §103.

Likewise, for a rejection under §103, the alleged prior art must itself suggest the desirability of the claimed invention. *See*, M.P.E.P. 2143.01 (Eighth Ed. Rev. 2, May 2004, p. 2100-129). However, no teaching or suggestion has been shown in the references to combine a die tossing device with nail polish or lipstick or so forth.

While it is true that "popomatic" devices have previously been provided in the art, it is not Applicant's contention that he has invented such a device. Rather, Applicant is the first to provide a cosmetics container (e.g. nail polish, lipstick, or so forth), which also includes a popomatic or other die tossing device therein. Die tossing devices have nothing to do with cosmetics containers, and it is respectfully submitted that the art does not teach or suggest such a novel and non-obvious combination.

Accordingly, in view of the foregoing, favorable action on the application is respectfully requested and believed to be fully warranted.

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Respectfully submitted,



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